



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087727,084	10/08/96	PULST	S P07-37217

18M1/0619  
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EXAMINER
ALLEN, M

ART UNIT	PAPER NUMBER
1818	

DATE MAILED: 06/19/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

08/727,084

Applicant(s)

Pulst

Examiner

Marianne P. Allen

Group Art Unit

1818



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-43 are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 40, and 43, drawn to nucleic acids encoding SCA2, classified in class 536, subclass 23.5.
- II. Claims 15 and 27-29, drawn to antisense oligonucleotides, classified in class 536, subclass 24.5.
- III. Claims 16-23, drawn to SCA2 polypeptides, classified in class 530, subclass 350.
- IV. Claims 24-26 and 30, drawn to antibodies, classified in class 530, subclass 387.1.
- V. Claims 31-36, drawn to transgenic animals, classified in class 800, subclass 2.
- VI. Claim 37, drawn to a method of identifying nucleic acids, classified in class 435, subclass 6.
- VII. Claim 38, drawn to a method of identifying binding compounds, classified in class 435, subclass 7.1.
- VIII. Claim 39, drawn to a method of detection using antibodies, classified in class 435, subclass 7.2.
- IX. Claims 41-42, drawn to a method of diagnosis, classified in class , subclass .

The inventions are distinct, each from the other because:

Groups I and II are related as nucleic acids encoding proteins and antisense oligonucleotides. The inventions can be shown to be distinct because the nucleic acids can be used to make the encoded proteins or the transgenic animal.

Groups I and III are related as nucleic acids encoding proteins and the protein itself. The inventions can be shown to be distinct because the proteins could have been isolated from natural sources or made synthetically rather than with the nucleic acid sequences of Group I.

Groups I and V are related as nucleic acid and transgenic animal. The inventions can be shown to be distinct because the nucleic acids can be used to make the encoded proteins rather than the transgenic animal.

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Groups I and (VI and IX) are related as nucleic acid and (method of identifying nucleic acids and method of diagnosis). The inventions can be shown to be distinct because the nucleic acids can be used to make the encoded proteins or the transgenic animal rather than in the methods of Groups VI and IX.

Groups III and IV are related as polypeptide and antibody. The inventions can be shown to be distinct because the polypeptides can be used in methods of treatment rather than to produce the antibodies of Group IV.

Groups III and VII are related as polypeptide and method of identifying binding compounds. The inventions can be shown to be distinct because the polypeptides can be used in methods of treatment rather than in the method of Group VII.

Groups IV and VIII are related as antibody and method of detection. The inventions can be shown to be distinct because the antibodies can be used in methods of treatment rather than in the method of Group VIII.

Groups I-V are related as nucleic acid, antisense oligonucleotides, polypeptide, antibody, and transgenic animal. Each product pair can be shown to be distinct because they are not structurally related and as set forth above. Groups I and (VII-VIII) are related as nucleic acid and methods that can be shown to be distinct because they do not use nucleic acids. Groups II and (VI-IX) are related as antisense oligonucleotides and methods that can be shown to be distinct because they do not use antisense oligonucleotides. Groups III and (VI, VIII, and IX) are related as polypeptides and methods that can be shown to be distinct because they do not use the polypeptides. Groups IV and (VI, VII, and IX) are related as antibodies and methods that can be shown to be distinct because they do not use antibodies. Groups V and (VI-IX) are related as transgenic animal and methods that can be shown to be distinct because they do not use the transgenic animal. Each of the methods of Groups VI-IX can be shown to be distinct, each from the other, because they have different methods steps, starting materials, and/or goals. The inventions of each named pair can be shown to be distinct because they do not rely upon each other for their ultimate use and they require non-coextensive literature searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Robert Ramos, Registration No. 37915, on 22 May 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached on (703) 308-4310. The most convenient FAX telephone number for this examiner is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
MARIANNE P. ALLEN  
PRIMARY EXAMINER  
GROUP 1800